

**MORRISON | FOERSTER****RECEIVED  
CENTRAL FAX CENTER****JAN 22 2007**755 PAGE MILL ROAD  
PALO ALTO  
CALIFORNIA 94304-1018  
TELEPHONE: 650.813.5600  
FACSIMILE: 650.494.0792  
WWW.MOFO.COMMORRISON & FOERSTER LLP  
NEW YORK, SAN FRANCISCO,  
LOS ANGELES, PALO ALTO,  
SAN DIEGO, WASHINGTON, D.C.,  
DENVER, NORTHERN VIRGINIA,  
ORANGE COUNTY, SACRAMENTO,  
WALNUT CREEK, CANTURY CITY  
TOKYO, LONDON, BEIJING,  
SHANGHAI, HONG KONG,  
SINGAPORE, BRUSSELS

To:

NAME:	FACSIMILE:	TELEPHONE:
MS APPEAL BRIEF - PATENTS U.S. Patent and Trademark Office	571-273-8300	571-272-8586

FROM: Thomas Chan

DATE: January 22, 2007

Number of pages with cover page:	9	Originals Will Not Follow
-------------------------------------	---	---------------------------

Preparer of this slip has confirmed that facsimile number given is correct: 12923/lca1

Comments:

**Official Filing**

Examiner: S. Kundu  
 Art Unit: 2863  
 U.S. Patent Application Serial No.: 10/772,327  
 Filing Date: February 6, 2004  
 Inventor(s): Ankan PRAMANICK et al.  
 Title: METHOD AND APPARATUS FOR TESTING INTEGRATED CIRCUITS  
 Docket No.: 333772000900

Papers enclosed herewith:

1. Transmittal Form (1 page)
2. Reply Brief (7 pages)

\*\*\*\*\*  
 To ensure compliance with requirements imposed by the United States Internal Revenue Service, Morrison & Foerster LLP informs you that, if any advice concerning one or more U.S. Federal tax issues is contained in this facsimile (including any attachments), such advice is not intended or written to be used, and cannot be used, for the purpose of (i) avoiding penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein.  
 \*\*\*\*\*

**CAUTION - CONFIDENTIAL**

This facsimile contains confidential information that may also be privileged. Unless you are the addressee (or authorized to receive for the addressee); you may not copy, use, or distribute it. If you have received it in error, please advise Morrison & Foerster LLP immediately by telephone or facsimile and return it promptly by mail.

PA-1125994

**RECEIVED  
CENTRAL FAX CENTER**

**JAN 22 2007**

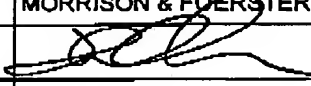
PTO/SB/21 (09-04)

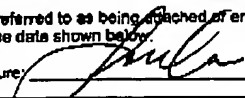
Approved for use through 07/31/2008. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/772,327
		Filing Date	February 6, 2004
		First Named Inventor	Ankan PRAMANICK
		Art Unit	2863
		Examiner Name	S. Kundu
Total Number of Pages in This Submission	8	Attorney Docket Number	333772000900

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences (7 pages)  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax cover sheet
Remarks: _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP (Customer No. 25226)		
Signature			
Printed name	Thomas Chan		
Date	January 22, 2007	Reg. No.	51,543

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.	
Dated: January 22, 2007	Signature:  (Lora Choi Abanador)

pa-1126002

JAN 22 2007

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no.: (571) 273-8300, on the date shown below.

Dated: 1/22/07

Signature: 

(Lora Choi Abanador)

Docket No.: 333772000900  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Ankan PRAMANICK et al.

Application No.: 10/772,327

Confirmation No.: 4514

Filed: February 6, 2004

Art Unit: 2863

For: METHOD AND APPARATUS FOR TESTING  
INTEGRATED CIRCUITS

Examiner: S. Kundu

**REPLY BRIEF**

MS APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer, dated November 20, 2006, for which a response was due on January 20, 2007. Since January 20 fell on a Saturday and January 21 fell on a Sunday. Accordingly, this response filed on January 22, 2007, is timely filed.

pa-1118916

Application No.: 10/772,327

2

Docket No.: 333772000900

**AMENDMENTS TO THE CLAIMS**

**I. STATUS OF CLAIMS**

**A. Total Number of Claims in Application**

There are 24 claims pending in application.

**B. Current Status of Claims**

1. Claims canceled: 0
2. Claims withdrawn from consideration but not canceled: 0
3. Claims pending: 1-24
4. Claims allowed: 0
5. Claims rejected: 1-24

**C. Claims on Appeal**

The claims on appeal are claims 1-24.

pa-1118916

Application No.: 10/772,327

3

Docket No.: 333772000900

**II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 1-5 are anticipated under 35 U.S.C. 102(b) by U.S. Patent No. 6,028,439 (the Arkin reference).

B. Whether claims 6-8, 24 are unpatentable under 35 U.S.C. 103(a) over the Arkin reference in view of US 2002/0183955 A1 (the Adler reference).

C. Whether claims 9-14, 19 are unpatentable under 35 U.S.C. 103(a) over the Arkin and Adler, and further in view of US 2003/0167277 A1 (the Hejlsberg reference).

D. Whether claims 15-18, 21-23 are unpatentable under 35 U.S.C. 103(a) over the Arkin reference.

E. Whether claim 20 is unpatentable under 35 U.S.C. 103(a) over the Arkin, Adler, and Hejlsberg, and further in view of US Patent No. 6,782,336 (the Shah reference).

pa-1118916

RECEIVED  
CENTRAL FAX CENTERJAN 22 2007  
4

Application No.: 10/772,327

Docket No.: 333772000900

## III. REPLY TO EXAMINER'S ANSWER

Appellants respectfully request consideration of the following remarks in view of the Examiner's Answer on Appeal mailed November 20, 2006. Appellants maintain the arguments set forth in Appellants' Appeal Brief filed on September 25, 2006.

**A) Applicants respectfully disagree with Examiner's interpretation of the site controller**

In Figure 2, the Examiner identifies the computer bus (38A) as the site controller. Applicants respectfully submit that person skilled in the art would understand that a computer bus consists of a set of hardware lines (metal conductors) used for data transfer among the components of a computer system. **Such hardware lines have no intelligence and thus they are incapable of controlling other electronic components.** On the contrary, the computer bus (38A) needs to be controlled by other electronic components, such as the bus controller (35), as shown in Figure 2 of the Arkin reference.

In the present case, independent claim 1 recite, in part, "at least one local operating system associated with each site controller for enabling control of at least one test module by an associated site controller" and "the associated site controller controls at least one test module interactively". Based on plain language interpretation of these claim elements, **Applicants submit that person skilled in the art would agree with the Applicants that the set of hardware lines would not be able to control the at least one test module interactively.** In addition, Applicants submit that person skilled in the art would not speak of a local operating system to be associated with a set of hardware lines as proposed by the Examiner.

**B) Applicants respectfully disagree with Examiner's interpretation of the system controller, site controller, and test module of the present invention**

On page 10 of the Examiner's Answer, the Examiner indicated that the test module contains the system controller and the site controller. In other words, both the system controller and the site controller are embedded in the test module. Applicants respectfully remind the Board that the Arkin

pa-1118916

Application No.: 10/772,327

5

Docket No.: 333772000900

reference clearly shows that "FIG. 2 illustrates a typical tester module of FIG. 1 in more detailed block diagram form" (See Arkin, C4:22-23.) Moreover, Arkin clearly indicates that FIG.2 is the test module 14(1) as labeled at the lower left corner of FIG. 2.

Claim 1 recites, in part, "a host operating system for enabling control of at least one site controller by a system controller" and "...enabling control of at least one test module by an associated site controller". Applicants respectfully submit that person skilled in the art would not consider the system controller and the site control to be embedded in the test module from reading the plain language of claim 1 and Figure 2 of the specification. Person skilled in the art would understand that a test module created by one vendor may not be able to interface with another test module created by a different vendor. Thus, **person skilled in the art would understand that the system controller and/or the site controller are not part of the test module, because the system controller and/or the site controller would be required to interface with different test modules provided by different vendors.**

**C) Applicants respectfully disagree with Examiner's interpretation of "plug-and-play"**

On page 11 of the Examiner's Answer, the Examiner cites the specification which merely describes an implementation of plug-and-play of the present invention. However, the Examiner avoided responding to the key issue identified by the Applicants throughout the prosecution that **a test module is different from a device-under-test (DUT)**. Even FIG. 1 of the Arkin reference supports the Applicants' position as it identifies the test modules being items 14(1), 14(2), and 14(3), and the DUT(s) as item 12. Because the test modules and the DUT(s) are totally different entities, Applicants submit that the ability to attach/detach the DUT(s) does not anticipate the ability to attach/detach the test modules.

In addition, if the Examiner's position of the site controller is part of the test module (see Examiner's label of FIG.2 of Arkin) is adopted, Applicants submit that it is impossible to attach or detach the test modules from the site controller in a plug-and-play manner as required by the

pa-1118916

**RECEIVED  
CENTRAL FAX CENTER**

Application No.: 10/772,327

**6 JAN 22 2007**

Docket No.: 333772000900

pending claim 1 (How can one separate the computer bus (38A), which is part of the test module, from the test module 14(1) according to the definition by the Examiner?).

**D) Response to Examiner's Additional Remarks**

Applicants agree that the pending claims must be "given the broadest reasonable interpretation consistent with the specification." However, Applicants submit that using a set of hardware lines (computer bus) to anticipate the functions of the site controller of the pending application is not a "reasonable interpretation consistent with the specification." Many computer systems contain multiple sets of hardware lines (computer buses). If a set of hardware lines (computer bus) is given the interpretation to anticipate any functionality (such as the site controller), then a computer system can almost anticipate any inventive electronic apparatus.

In addition, Applicants would like to bring the attention to the Board that Applicants added the clarification to claim 1 of the pending application regarding the interaction between the site controller and the test module, and added the limitation common clock according to the Examiners' suggestions on the April 13, 2006 interview that these limitations would distinguish the pending claims from the Arkin reference.

pa-1118916



RECEIVED  
CENTRAL FAX CENTER

009/009

JAN 22 2007

Application No.: 10/772,327

7

Docket No.: 333772000900

**CONCLUSION**

For the foregoing reasons, Appellants assert that the Examiner's rejections of claims 1-24 are erroneous and that the claims are patentable. Reversal of the rejections is therefore respectfully requested.

The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 1.17 that may be required by this Reply Brief to the Examiner's Answer, or to credit any overpayment, to Deposit Account No. 03-1952 referencing attorney docket no. 333772000900.

Dated: January 22, 2007

Respectfully submitted,

By 

Thomas Chan

Registration No.: 51,543  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5616

pa-1118916